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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1291.1174101

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on AUGUST 1, 2007Signature Typed or printed name THU H. LE-TO

Application Number

10/713,820

Filed

NOVEMBER 14, 2003

First Named Inventor

THOMAS W. DAVISON

Art Unit

3734

Examiner

NGUYEN, VI X.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.
Registration number 40,364

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



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8/1/07

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

P A T E N T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: THOMAS W. DAVISON et al. Confirmation No.: 2572
Serial No.: 10/713,820 Examiner: NGUYEN, VI X
Filed: NOVEMBER 14, 2003 Group Art Unit: 3734
Docket No.: 1291.1174101 Customer No.: 28075
Title: CANNULA FOR RECEIVING SURGICAL INSTRUMENTS

PRE-APPEAL CONFERENCE BRIEF

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Thu H. Le-To

AUGUST 1007

Date

Applicants submit that the Examiner's rejections contain at least the following clear errors and/or omissions of one or more essential elements needed for a *prima facie* rejection.

Claims 44, 45, and 47-57 are rejected as being anticipated by Murdock. Applicants submit the rejection is in error because the Murdock reference fails to teach each and every element of the claims, as is required for anticipation. See MPEP 2131. The Examiner asserts that Murdock teaches a device having an arcuate guide 40 which is inherently having an elongate length along a portion of the elongated body that is able to move from its contracted condition to its expanded condition. Applicants submit that there is no basis for such an interpretation. MPEP 2112 IV. states:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily

present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

(Emphasis added). Applicants submit that the claimed apparatus, in particular the structure of the claimed arcuate guide, is not necessarily present in Murdock. It appears the Examiner is asserting that the structure of Murdock could be modified to achieve the claimed structure of the arcuate guide. This is not a proper basis for an anticipation rejection.

Independent claim 44 recites, in part, "an arcuate guide having an elongate length, a first end and a second end along which a portion of the elongate body is moveable from its contracted condition to its expanded condition, the arcuate guide extending generally in the direction of expansion between the contracted and expanded conditions." Emphasis added. Murdock does not appear to teach such a structure. The Examiner asserts the cam ring 40 of Murdock is equivalent to the arcuate guide recited in the claims. The cam ring 40 of Murdock does not appear to have an elongate length, a first end and a second end along which a portion of the elongate body is moveable, and to be extending generally in the direction of expansion between the contracted and expanded conditions. Murdock teaches:

a rigid cam ring 40 that is constantly in camming engagement with the spaced apart cammable surfaces of a circular series of rigid clips 41 which are of recurvate or hairpin shape and fixed respectively on the inside surfaces of the blades 33. The U-shaped portions of all the clips 41 are engaged by the single camming ring 40 at a point in the length of the instrument spaced sufficiently far from the socket member 16 of the pivotal joint to effect simultaneous flexure of each blade in its portion between the camming ring and the socket member.

Emphasis added; see column 4, lines 19-29. Murdock specifically teaches element 40 as a cam ring. Applicants submit that the structure of the cam ring 40 appears to be a continuous structure and thus cannot be considered to have first and second ends as is recited in the claims. FIGS. 4-5 of Murdock show the relationship between the cam ring 40, clips 41, and the blades 33 in the contracted position (FIG. 4) and the expanded position (FIG. 5). The

figures and description of Murdock appear to show that the cam ring 40 presses against the clips 41, causing contraction of the blades 33 (FIG. 4) and then slides back, causing expansion of the blades 33 (FIG. 5). The cam ring 40 of Murdock appears to be constantly in contact with the clips 41. The cam ring 40 of Murdock does not appear to have an elongate length along which a portion of the elongate body is moveable from a contracted condition to an expanded condition, and to be extending generally in the direction of expansion between the contracted and expanded conditions, as is recited in the claims. Rather, Murdock appears to teach the cam ring 40 sliding back and forth along the clips 41, however, no portion of the elongate body appears to be moveable along an elongate length of the cam ring, with the arcuate guide extending generally in the direction of expansion between the contracted and expanded conditions. Further, as the continuous ring structure of Murdock's cam ring 40 does not have first and second ends, the cam ring 40 cannot be interpreted as an arcuate guide "having a first end and a second end along which a portion of the elongate body is moveable," as is recited in claim 44.

MPEP 2131 states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)."

Emphasis added. As discussed above, Murdock does not appear to teach the identical invention in as complete detail as is recited in independent claim 44 and the claims dependent thereon. The anticipation rejection is thus in error.

Independent claim 50 recites, in part, "a guiding mechanism comprising a curved elongate portion extending in a generally transverse direction along which a portion of the elongate body is moveable from its contracted condition to its expanded condition". Emphasis added. Murdock does not appear to teach such a structure. The Examiner appears to be equating the clips 41 of Murdock with the guiding mechanism comprising a curved elongate portion recited in the claims. As shown in FIGS. 4-5 of Murdock, the clips 41 do not appear to extend in a transverse direction and a portion of the elongate body does not appear

to be moveable along a curved elongate portion of the clips 41. Rather, Murdock teaches "rigid clips 41 which are of recurvate or hairpin shape and fixed respectively on the inside surfaces of the blades 33." See column 4, lines 21-23. The portion of the elongate body of Murdock that is moveable from a contracted condition to an expanded condition appears to be the blades 33, which are fixed to the clips 41. The clips 41 thus cannot be seen to have a curved elongate portion along which a portion of the elongate body is moveable, as is recited in the claims.

The Examiner appears to be asserting that the cam ring 40 of Murdock is the equivalent of the claimed guiding mechanism. Applicants respectfully disagree and submit that the Examiner has not provided the necessary showing of equivalence. MPEP 2183 states that making a *prima facie* case of equivalence requires:

- If the examiner finds that a prior art element
- (A) performs the function specified in the claim,
 - (B) is not excluded by any explicit definition provided in the specification for an equivalent, and
 - (C) is an equivalent of the means- (or step-) plus-function limitation,
the examiner should provide an explanation and rationale in the Office action
as to why the prior art element is an equivalent.

As discussed above, the cam ring 40 of Murdock appears to be in constant camming engagement with clips 41 that are in turn fixed to blades 33, such that when forced toward the hinge joint, ring 40 performs a camming action against the clips 41 that causes simultaneous flexure of the blades radially outward to expand the distal portion 13, and when forced toward the distal end of the instrument, ring 40 causes inward flexure of the blades, contracting the distal portion 13. See column 4, lines 19-23 and 36-44. The cam ring 40 of Murdock does not appear to perform the same function of the arcuate guide of independent claim 44 or the guiding mechanism of independent claim 50. Further, the Examiner has not provided an explanation and/or rationale as to why the Murdock structure is an equivalent of the claimed arcuate guide or guiding mechanism. The Examiner has thus failed to provide the necessary elements for a *prima facie* case of equivalence. The rejection is thus in error.

For at least the reasons set forth above, Murdock does not appear to teach each and every element of the independent claims 44 and 50 and the claims dependent thereon, as is

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Reply to Final Office action dated May 1, 2007

required for an anticipation rejection. Murdock thus cannot be seen to anticipate the claims. Further, there is no suggestion or motivation for one of ordinary skill in the art to modify the device of Murdock to achieve the device as claimed. Reconsideration and withdrawal of the rejection are respectively requested.

Reconsideration and withdrawal of the rejection are respectfully requested. It is submitted that, in light of the above remarks, all pending claims are now in condition for allowance. If a telephone interview would be of assistance, please contact the undersigned attorney at 612-677-9050.

Respectfully submitted,
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By their attorney,

Date: 8/1/07



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